

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Bong-Jin LEE, et al.

Serial No.: 08/876,179

Filed: 13 June 1997

For: A HARD DISK DRIVE WITH CONNECTORS THAT SIMPLIFY ASSEMBLY  
(As Amended)



Examiner: GUSHI, ROSS

Art Unit: 2833


**TRANSMITTAL OF APPELLANT'S BRIEF FEE**

Assistant Commissioner  
for Patents  
Washington, D.C. 20231

Sir:

Accompanying this transmittal is a check drawn to the U.S. Department of Treasury in the amount of \$300.00 for the filing a Brief in support of a Notice of Appeal on 7 June 1999. Should any additional fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 in that amount. Please inform the Applicant of any transactions involving the Deposit Account.

Respectfully submitted,

  
Robert E. Bushnell  
Attorney for Applicant  
Reg. No.: 27,774

1522 "K" Street, N.W., Suite 300  
Washington, D.C. 20005  
Area Code: 202-638-5740

Folio: P54596  
Date: 9 August 1999  
I.D.: REB/mf

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1 15. The hard disk drive of claim 12, further comprised of said terminals being hook  
2 shaped.

1 16. The hard disk drive of claim 12, further comprised of said terminals being V-shaped.

1 17. The hard disk drive of claim 12, further comprised of said first connector and said  
2 second connector each being a 14 pin type of connector.

1 18. The hard disk drive of claim 12, further comprised of said contacts and said terminals  
2 each being a 4 pin type of connector.

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For: A HARD DISK DRIVE WITH CONNECTORS THAT SIMPLIFY ASSEMBLY  
(as amended)



**PETITION UNDER 37 C.F.R. §1.181**

Assistant Commissioner  
for Patents  
Washington, D.C. 20231

Sir:

Applicant respectfully petitions from the failure of the Examiner in the Advisory action of 14 May 1999 (Paper No. 14) to enter Applicant's Amendment After Final filed on 15 April 1999, and as reasons therefor states that:

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Date: 8/9/99  
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### STATEMENT OF FACTS

1. On June 13, 1997 Applicant filed application with 11 claims in the U.S. Patent & Trademark Office.
2. On July 22, 1998 the Examiner issued a first Office action (Paper No. 5) where all eleven (11) claims were rejected under 35 U.S.C. §112, second paragraph, 35 U.S.C. §102 and 35 U.S.C. §103.
3. On October 22, 1998, Applicant filed an Amendment to the outstanding Office action wherein Applicant amended Claims 1 through 8 and Claims 10 and 11, canceled Claim 9 and added Claims 12 through 18.
4. On January 5, 1999, the Examiner issued a final Office action (Paper No. 7) rejecting Claims 1 through 8 and 10 through 18 under 35 U.S.C. §112, first paragraph, 35 U.S.C. §112, second paragraph, 35 U.S.C. §102 and 35 U.S.C. §103.
5. On April 5 1999, Applicant filed an Amendment under 37 C.F.R. §1.116(b) amending Claims 1, 3, 6, 8, and 12 to overcome the 35 U.S.C. §112, first and second paragraph rejections. In addition, Applicant argued the art rejections of the claims.

6. On April 16, 1999 the Examiner issued an Advisory action (Paper No. 11) where the Examiner rejected again all the claims and refused to enter any of the amendments after final.
7. On April 27, 1999 Applicant filed a Request for Consideration After Final to try to enter the amendments after final.
8. On May 14, 1999, the Examiner issued a second Advisory action (Paper No. 14) repeating his prior Advisory action by rejecting all the claims and refusing to enter any of the amendments after final.

#### **ARGUMENTS/REMARKS**

In Paper Nos. 11 and 14, the Examiner stated that all of the claims, 1 through 8 and 10 through 18 remain rejected and the Examiner refused to enter any of the amendments after final because the Examiner states:

"applicant's arguments advocating the entering of amendments after final rejection are not persuasive; the amendments regarding first and second circuit boards and automatic engagement are new matter requiring substantial consideration."

Regarding the claim that the first and second circuits board are considered new matter, Applicant points out that the claims prior to final amendments state "a printed circuit board" and "a

printed circuit board assembly." Thus, the claim already contained two separate circuit boards. This is evidenced by Claims 1, 6, and 12. For these reasons, the Examiner was in error in stating that the first and second circuit boards are new matter.

Regarding the second claim by the Examiner that automatic engagement is new matter, Applicant cites the Summary of the Invention section of the specification, page 3, lines 3 and 4 where it states, "an electrical connection between a head disk assembly in a flexible printed circuit board is automatically made upon mounting a printed circuit board on a head/disk assembly." Applicant cites original Claim 1 as filed on June 13, 1997 where it says "said second plurality of connector pins being automatically connected when said first connector is connected." Claim 6 of the originally filed application says "said second connector automatically electrically connecting said printed circuit board to said head/disk assembly when said first connector connects said printed circuit board to said head/disk assembly." Claim 9 of the originally filed application of June 13, 1997 says "said connector automatically connecting said head disk assembly to said printed circuit board when attaching said hard disk drive to said head disk assembly." Thus, it is not new matter that the term "automatic" is to be entered in the Amendment After Final in the claims.

Finally, the Examiner claims that entry of the Amendment After Final would require substantial consideration. However, Applicant quotes from the Examiner's final Office action (Paper No. 7) where he states "again, either there are two or more printed circuit boards which are not

distinguished in the claims, or there is a single circuit board which is claimed multiple times in the same claim. Independent claims 6 and 12, although worded slightly differently, have the same ambiguities." Thus, the Examiner was already aware of the fact that there might have been more than one printed circuit board in Applicant's claims and the Examiner should have been prepared to examine the possibility of more than one circuit board at the stage in prosecution.

For these reasons, Applicant contends that the Examiner's assertion that the substantial consideration will be imposed on the Examiner if the amendments after final were entered, is without merit.

**RELIEF REQUESTED**

In view of the above, the Commissioner is respectfully requested to:

- A. Enter the Amendment After Final filed by Applicant on April 5, 1999; and
- B. Grant Applicant such other and further relief as justice may require.

Respectfully submitted,

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Robert E. Bushnell  
Attorney for the Applicant  
Registration No.: 27,774

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Washington, D.C. 20005  
(202) 638-5740

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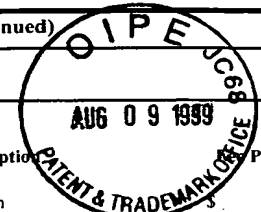


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PTO/SB/17 (2/98)  
2833

Approved for use through 9/30/2000. OMB 0651-0032  
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<h1 style="margin: 0;">FEE TRANSMITTAL</h1> <p style="margin: 5px 0;">Patent fees are subject to annual revision on October 1. These are the fees effective October 1, 1997. Small Entity payments <u>must</u> be supported by a small entity statement, otherwise large entity fees must be paid. See Forms PTO/SB/09-12. See 37 C.F.R. §§1.27 and 1.28.</p>				Complete If Known																																																																																																																																																																																					
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Typed or Printed Name		Robert E. Bushnell, Esq.		Reg. Number		27,774																																																																																																																																																																																			
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